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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,168	06/14/2001	Scott H. Freeman	FREEM-174X	1442

7663 7590 07/26/2002

STETINA BRUNDA GARRED & BRUCKER  
75 ENTERPRISE, SUITE 250  
ALISO VIEJO, CA 92656

EXAMINER
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YEUNG, JAMES C

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 07/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/883,168

Applicant(s)  
Freeman et al.

Examiner  
James C. Yeung

Art Unit  
3743



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 14, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☒ Claim(s) 23-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other:

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## **DETAILED ACTION**

### ***Reissue Applications***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 24, and 27-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey

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to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- The examiner can find no basis in the specification as filed to support the subject matter in line 2 of claim 24 requiring that the gelatinous structure defines **at least one exposed edge which is round**. A traversal of this rejection must specifically point out what portions of the original filed disclosure upon which applicants rely on to support the claim. The claim language must find antecedent basis in the specification. See 37 CFR. 1.75 (d)(1). Please use language in the claim which is found in the original description of the invention.

- The examiner can find no basis in the specification as filed to support the subject matter in lines 2 and 4 of claim 27 requiring that the gelatinous structure defines **at least one exposed edge**. A traversal of this rejection must specifically point out what portions of the original filed disclosure upon which applicants rely on to support the claim. The claim language must find antecedent basis in the specification. See 37 CFR. 1.75 (d)(1). Please use language in the claim which is found in the original description of the invention.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

6. Claims 23-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Freeman (U.S.

Pat. 6,214,295). The structure as claimed is fully anticipated by Freeman (note Fig. 5).

7. Claims 23-31 are rejected under 35 U.S.C. 102(e) or 102 (g)(2) as being anticipated by

Freeman reference (U.S. Pat. 6,214,295) which has a common assignee with the instant

application. Based upon the earlier effective U.S. filing date of the copending application, it

would constitute prior art under 35 U.S.C. 102(e) or 102(g)(2). This rejection under 35

U.S.C. 102(e) or 102(g)(2) might be overcome either by a showing under 37 CFR 1.132 that any

invention disclosed but not claimed in the reference was derived from the inventor of this


application and is thus not the invention "by another," or by an appropriate showing under 37

CFR 1.131.

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8. Claims 23-31 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The Freeman reference (US Pat. 6,214,295) discloses the invention as claimed (note Fig. 5). This rejection is based upon the different inventorship of the Freeman reference and the instant application.

9. Claims 23-31 directed to an invention not patentably distinct from claims 1-18 of commonly assigned U.S. Pat. 6,214,295. Specifically, claims 23-31 of the present application are of broader scope than the claims of U.S. Pat. 6,214,295. Thus, claims 23-31 are obviously readable on claims 1-18 of U.S. Pat. 6,214,295.

A handwritten bracket on the right side of the page, spanning the vertical distance of paragraph 9. It starts at the level of the first line of paragraph 9 and ends at the level of the last line. To the right of the bottom of the bracket are the handwritten initials "J.P."


Commonly assigned patent, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78 © and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James C. Yeung whose telephone number is (703) 308-1047. The facsimile phone number for this Art Unit is (703) 308-7764.

JY  
July 24, 2002

  
James C. Yeung  
Primary Examiner